

Remarks

Reconsideration of the instant application is respectfully requested in light of the following remarks.

I. STATUS OF THE CLAIMS

Claims 1-37 are now pending. Claims 26 and 34 have been withdrawn from consideration by the Examiner. Claims 30-33 and 35-37 have been allowed. Claim 10 has been found to be allowable but objected to. No claims have been added, amended, or cancelled.

II. ELECTION/RESTRICTION

The Examiner asserted that the originally filed claims required restriction to one of two inventions as follows: Group I – claims 1-25, 27-33, and 35-37 drawn to a moisturizing composition; or Group II – claims 26 and 34 drawn to methods of using a composition to impart moisture to the skin. On February 20, 2004, a provisional election was made with traverse to prosecute the invention of Group I. Although applicants do not agree that restriction is required in this case, applicants nevertheless confirm the provisional election to prosecute Group I, claims 1-25, 27-33, and 35-37. Applicants will cancel the withdrawn claims upon indication of allowance of the remaining claims by the Examiner.

III. CLAIMS 1-9, 11-25, AND 27-29 ARE PATENTABLE OVER THE EXAMINER'S CITED PATENTS

A. The Claims are Patentable over U.S. Pat. No. 6,627,585

The Examiner rejected claims 1-9, 11-25, and 29 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,627,585 issued to Steer ("Steer"). More specifically, the Examiner asserted Steer is directed to a mousse-foaming cleansing shampoo which may contain any of a wide variety of compounds including surfactants, ester compounds, and, optionally, cationic deposition polymers. However, as acknowledged by the Examiner, "Steer does not specifically teach a detergent composition containing a cationic polymer, a diester or trimester emollient, a monoester emollient, a cleansing surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims."

Nevertheless, the Examiner concluded that it would have been obvious to one of skill in the art to make a composition of the claimed invention, with a reasonable likelihood of success, in light of Steer because, in essence, the broad teachings therein potentially encompass at least certain compounds of the claimed invention.

In reply, as discussed in further detail below, applicants respectfully submit that Steer fails to teach or suggest any compounds of the claimed invention nor any significant unexpected advantages associated with such compounds as compared to other compounds potentially encompassed by the extremely broad teachings of Steer. Therefore, Steer fails to render the claimed invention unpatentable, and the Examiner's rejections should be withdrawn.

Steer is directed to a foamable concentrate comprising at least one surfactant, which composition may (or may not) further comprise any of a variety of compounds selected from a variety of very broad classes of compounds including silicones, high molecular weight hydrocarbons, and/or oily or fatty materials including certain mono-, di-, and tri-carboxylic esters. In addition, the compounds of Steer may, optionally, further comprise a cationic deposition polymer. However, Steer clearly fails to teach or suggest specifically combining a cationic polymer, a monoester compound, a cleansing surfactant, and an emollient selected from diesters, triesters, or combinations thereof to achieve a compound of the claimed invention.

Rather, Steer merely identifies an extremely vast laundry list of *potential* broad classes of compounds which might be combined to form any of the *virtually innumerable* (possibly hundreds, thousands, or more) potential mousse compositions encompassed by the combinations of classes of Steer compounds. Clearly Steer cannot be said to teach or even suggest exploring each and every possible combination of compounds encompassed therein to achieve a compound of the instant invention with a reasonable expectation of success merely because such claimed compounds are potentially encompassed within the broad, broad genus of possible compounds disclosed therein. See, for example, MPEP 2144.08. Instead, as recognized in the MPEP, one must consider both the size of the genus disclosed in Steer, as well as any specific teachings of compositions therein, in determining whether such disclosure motivates one of skill to achieve the specific combination of compounds required for the claimed invention.

Here, the genus of compounds encompassed by the potential combinations of compounds from broad classes of compounds is vast. In addition, none of the specific compounds (Examples 1 and 2) of Steer provide any teachings of compositions comprising the specific combination of compounds instantly required from amongst the vast genus. Accordingly, applicants submit that there is no motivation or reasonable likelihood of success provided by Steer to achieve a compound of the claimed invention from the virtually innumerable Steer compositions. Therefore, the Examiner's rejection should be withdrawn.

Furthermore, applicants respectfully submit that the Examiner's suggestion that it would be obvious to formulate a compound of the claimed invention from the teachings of Steer because Steer discloses fatty ester and oil compositions, emollients, and cationic polymers are among the broad varieties of compounds that can optionally be combined with a surfactant to form a mousse is, in essence, merely a suggestion that it would be obvious to try any of the potential vast numbers of combinations encompassed by Steer to achieve the present composition. While such an "obvious to try" rationale is never proper to support a rejection under 35 U.S.C. 103, it is particularly untenable here where, in the clear absence of any specific teachings to combine the required components of the claimed compositions, one of skill would be subject to an extreme undue burden to try the various, virtually innumerable combinations of Steer to achieve the particular combination of the claimed invention. Therefore, the Examiner's rejection is improper and should be withdrawn.

Moreover, applicants respectfully submit that Steer fails to teach or suggest any significant unexpected advantages associated with the claimed compositions. In particular, applicants have discovered unexpectedly that the claimed compositions exhibit properties that are significantly preferred by uses thereof as compared to other compounds that are potentially within the broad scope of compound combinations disclosed in Steer.

As described in Example 5 and illustrated, for example, in Table 5 of the instant application, applicants conducted a blind comparative consumer study with a composition of the instant application versus five other commercially available cleansers including an "Aveeno Baby Cleanser" and "oil of Olay Sensitive Skin Foaming Facial Wash", both of which, as described in the attached 132 Declaration of Joseph Librizzi, comprise combinations of components not within the instant claim

scope, but otherwise arguably within the broad classes of components taught by Steer (i.e. comprising water, surfactants, with optional silicones, high molecular weight hydrocarbons, fatty acid ester/oils, perfumes, and the like). As a result, applicants discovered that of the 66 properties tested and surveyed in Table 5, the compounds of the claimed invention scored at least as good as, and more importantly, even better or significantly better in 60 (91%) of the tested characteristics. In 22 of the 66 characteristics (33%), the claimed invention was preferred by at least 6 or more percentage points, and in 13 of the characteristics (20%), including "helps skin look and feel healthier," "helps to even out blotch and uneven skin tone," "helps unclog pores," "helps improve skin texture," "effective cleanser," "leaves skin feeling clean," "leaves skin feeling refreshed," "removes makeup and cleanses in one step," "good for even very dry skin," "a product for someone like me," "good consistency or thickness," "good for sensitive skin," "gentle to skin," and "high quality product," the claimed invention scored from *10 to 16 percentage points higher* than the next highest scoring product. As evidenced by such data, the compounds of the claimed invention have significant unexpected advantages associated therewith as compared to other compositions comprising components from among the broad classes of components disclosed in Steer.

Because Steer fails to teach or suggest any compositions comprising the particular combination of components required in the claimed invention and fails to teach, suggest or recognize the unexpected advantages associated with such compositions as compared to other compositions derivable from the teachings therein, applicants respectfully submit that the claimed invention is patentable over Steer. Accordingly, the Examiner's rejection should be withdrawn and the rejected claims allowed.

B. The Claims are Patentable over U.S. Pat. No. 5,837,661 and WO 95/00116

The Examiner further rejected claims 1-9, 11-25, and 29 under 35 U.S.C. 103(a) in light of U.S. Pat. No. 5,837,661, issued to Evans et al ("Evans"), and claims 1-9, 11-25, and 27-29 under 35 U.S.C. 103(a) in light of WO 95/00116 ("the '116 application.")

Applicants respectfully submit that the rejected claims are patentable over Evans and the '116 application for essentially the same reasons as asserted above with regard to Steer. That is, while both Evans and the '116 application disclose compositions which may include, amongst various other components, any of a wide variety of components including surfactants, fatty acids and esters (disclosed for different uses), and/or cationic compounds, neither document teaches, as acknowledged by the Examiner, any particular composition comprising the required components of the claimed invention, nor provides any motivation, suggestion, or recognition to achieve the claimed compositions having unexpected advantages associated therewith. Rather, the only way to derive the claimed compositions would be to optimize or try the virtually innumerable number of potential compositions derivable from Evans and/or the '116 application, which would require an undue burden on one of skill in the art. For all of these reasons individually and/or in combination, the Examiner's rejection should be withdrawn the rejected claims allowed.

IV. ALLOWABLE SUBJECT MATTER

The Examiner indicated that claim 10 as originally filed was objected to but allowable if rewritten in independent form. Applicants thank the Examiner for the finding of allowability and note that in light of the remarks herein, claims 1 and 7 from which claim 10 depends should now be allowed and the Examiner's object to claim 10 withdrawn.

The Examiner further allowed claims 30-33 and 35-37. Applicants thank the Examiner's for allowing such claims.

V. DOUBLE PATENTING

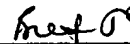
The Examiner provisionally rejected claims 1-9, 11-25, and 29 under the double patenting doctrine as being unpatentable over claim 20 of copending application no. 09/954,335.

Applicants respectfully disagree with the Examiner's rejection. Nevertheless, applicants respectfully submit that all other substantive rejections have been overcome, thus the Examiner's provisional rejection should be withdrawn and the claims allowed. (MPEP 804.I.B).

VI. CONCLUSION

Reconsideration is respectfully requested. In view of the above amendments and remarks, it is urged that the present application be allowed. An early and favorable response is earnestly solicited.

Respectfully submitted,



Brett Freeman
Reg. No. 46,709
Attorney for Applicant(s)

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-3428
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